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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,154	07/08/2003	Michael A. Epstein	PHA 23,636A	8245

7590 12/19/2003

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EXAMINER

LABAZE, EDWYN

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 12/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/615,154	EPSTEIN, MICHAEL A.	
	Examiner	Art Unit	
	EDWYN LABAZE	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>70820003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of IDS filed on 7/8/2003.
2. This application is a divisional of application No. 09/454,350 (now US patent 6,601,046) filed in 12/30/1999 and claims the benefits of application no. 60/126,167 filed in 3/25/1999.
3. Claims 1-8 are presented for examination.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Marshall et al. (U.S. 4,933,969).

Re claim 1: Marshall et al. discloses data authentication and protection system, which includes a memory [or storage means 19 as shown in Fig. # 1 of Marshall et al.] that is configured to store content material [which could a message, a song, or the like] (col.4, lines 55+; col.5, lines 14+), a usage indicator 40 that is configured to record a measure of usage associated with the content material of this recording medium (col.7, lines 43-67; col.8, lines 1-67), and a baseline register 32 that is configured to store at least one baseline-storage parameter that facilitates a determination of a validity period [using the message authentication code/MAC 42] associate with the content material based on the usage indicator (col.9, lines 53-67; col.10, lines 1-67).

Re claim 2: Marshall et al. teaches a system, wherein the usage indicator includes a counter 40 that is configured to be incremented a playback device when the playback device accesses the content material (col.7, lines 45-55; col.8, lines 54-65).

Re claim 3: Marshall et al. discloses a system, wherein the at least one baseline-storage parameter includes a copy/receipt of the measure of usage of the recording medium when the content material is stored in the memory (col.9, lines 40-52; col.15, lines 11-67; col. 16, lines 1-38).

Re claim 4: Marshall et al. teaches a system, wherein the at least one baseline-storage parameter includes also includes a usage limit [using a timer 98] that facilitates the determination of the validity period (col.20, lines 66-68; col.21, lines 21+).

Re claims 5 and 6: Marshall et al. discloses a system, wherein the at least one baseline-storage parameter is stored and associated with the content material/message in the baseline register in a secure form that facilitates a determination of an authenticity of the at least one baseline-usage parameter (col.9, lines 53-68; col.10, lines 1-49).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall et al. (U.S. 4,933,969) in view of England et al. (U.S. 6,327,652).

The teachings of Marshall et al. have been discussed above.

Marshall et al. fails to fails a digital signature bound to at least one baseline parameter.

England et al. discloses loading and identifying a digital rights management operating system, which includes a digital signature bound to at least one baseline parameter (col.8, lines 40-67; col.9, lines 1-29; col.11, lines 53-67; col.12, lines 1-52)

In view of England et al.'s teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ into the teachings of Marshall et al. a means of instructing the program to verifying a digital signature associated with the content material. Furthermore, such instruction would represent an additional parameter for determining the authenticity of the user, providing more security, and protecting the trusted right by allowing access of the downloaded content to a validated subscriber. Moreover, such modification would have been an obvious extension as taught by Marshall et al., therefore an obvious expedient.

Allowable Subject Matter

8. Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record, Marshall et al., cited by the examiner taken alone or in combination with any other references fail to teach a content material comprising of a watermark and wherein the

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at least one baseline parameter includes a ticket that is based on a hash value of the watermark. These limitations in conjunction with other limitations in the claimed invention were not shown by the prior art of record.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Van De Pavert (U.S. 5,914,471) discloses method and apparatus for recording usage data of a card operating devices.

Kocher et al. (U.S. 6,289,455) teaches method and apparatus for preventing piracy of digital content.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (703) 305-5437. The examiner can normally be reached on 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

el
Edwyn Labaze
Patent Examiner
Art Unit 2876
December 5, 2003



**THIEN M. LE
PRIMARY EXAMINER**